

Appl. No. 09/929,147
Amdt. dated November 3, 2005
Reply to Office action of August 10, 2005

REMARKS/ARGUMENTS

Applicant has received the Office action dated August 10, 2005, in which the Examiner:

- rejected claim 43 under 35 U.S.C. § 112, second paragraph;
- rejected claims 1-17, 19-21, 36-38, 40-42 and 57 under 35 U.S.C. § 101;
- rejected claims 43-45 and 48 as being anticipated by Macon;
- rejected claims 1, 3, 5, 7, 10, 22-24, 27, 36-38, 41, 50-52 and 55 as obvious over Macon in view of Lehman (U.S. Pat. No. 6,658,437);
- rejected claims 2, 4 and 11 as obvious over Macon in view of Lehman '437 and Lehman (U.S. Pat. No. 5,732,402);
- rejected claims 6 and 13 as obvious over Macon, Lehman '437 and Yamagami;
- rejected claims 8, 13, 26, 33, 40 and 54 as obvious over Macon in view of Lehman '437 and Zwilling;
- rejected claims 15-17, 20, 29, 30, 31 and 34 as obvious over Macon in view of Lehman '437 and Grossier;
- rejected claim 19 under 35 U.S.C. § 103(a) as obvious over Macon in view of Lehman '437, Grossier and Zwilling;
- rejected claim 33 under 35 U.S.C. § 103(a) as obvious over Macon in view of Grossier, Lehman '437 and Zwilling;
- rejected claim 47 as obvious over Macon in view of Zwilling;
- rejected claim 57 as obvious over Macon in view of Lehman '437 and Bilbrey;
- rejected claims 1, 3, 5, 7, 10, 22-24, 27, 36-38, 41, 50-52 and 55 as obvious over Macon in view of Shoroff;
- rejected claims 2, 4 and 11 as obvious over Macon in view of Shoroff and Lehman '402;
- rejected claims 6 and 12 as obvious over Macon in view of Shoroff and Yamagami;
- rejected claims 8, 13, 26, 33, 40 and 54 as obvious over Macon in view of Shoroff and Zwilling;

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- rejected claims 15-17, 20, 29, 30, 31 and 34 as obvious over Macon in view of Shoroff and Grossier;
- rejected claim 19 as obvious over Macon in view of Shoroff, Grossier and Zwilling;
- rejected claim 33 as obvious over Macon in view of Grossier, Shoroff and Zwilling;
- rejected claim 47 as obvious over Macon in view of Zwilling;
- rejected claim 57 as obvious over Macon in view of Shoroff and Bilbrey;
- objected to claims 9, 14, 21, 28, 35, 42, 49 and 56 as being dependent upon a rejected base claim, but otherwise allowable.

With this Response, Applicant has amended claims 1, 10, 15, 36, and 43. Based on the amendments and arguments contained herein, Applicant believes all claims to be in condition for allowance.

I. THE § 112, SECOND PARAGRAPH, REJECTION

The Examiner states that the phrase "each word" lacks antecedent basis. Applicant amends claim 43 to remove the phrase containing the limitation "each word" so as make moot the Examiner's rejection of claim 43. Applicant also added the "for" which was inadvertently omitted.

II. THE § 101 REJECTIONS

The various § 101 rejections have been addressed by amendment.

III. THE § 102 REJECTIONS

Claim 43 requires "consulting at least one usage counter that indicates how many adjacent clusters are available for storing data." In the final Office action dated January 26, 2005, pages 33-34, the Examiner specifically stated that Macon does not disclose this claim limitation. In the present Office action, however, the Examiner indicates that Macon does disclose this limitation. At a minimum, clarification is requested as to the Examiner's position.

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At any rate, Macon does not disclose this limitation. The Examiner identifies col. 6, lines 8-12 of Macon which state:

According to the present invention, however, a packed version of the FAT serves two important functions: it contains the allocation information for each FAT storage unit in the form of a count of contiguous clusters with a single group of clusters, and it indicates which allocation units are free for assignment to a file that is being created or extended.

This sentence, however, does not teach a usage counter that indicates how many adjacent clusters are available for storing data. The FAT "indicat[ing] which allocation units are free for assignment to a file" is substantially different than a counter that indicates the number of available adjacent clusters. Indicating which allocation units are free does not necessarily mean counting the number of available clusters that are free. At least for these reasons, claim 43 and dependent claims 44, 45, and 48 are not anticipated by Macon.

IV. THE § 103 REJECTIONS

Claim 1 requires "a counter indicative of a number of sets of adjacent bits that are set in words of the second data structure, wherein a second data structure bit that is set indicates that one or more clusters of objects associated with said bit are free for storage of data." Thus, claim 1 requires a counter that counts bits in a particular data structure, that data structure being one in which each bit indicates whether one or more clusters of objects associated with the bit are free for storage of data.

With regard to the rejection of claim 1 over Macon in view of Lehman '437, the Examiner has split this claim limitation into two parts. A first comprises "a counter indicative of a number of sets of adjacent bits that are set in words of the second data structure" and a second part comprises "wherein a second data structure bit that is set indicates that one or more clusters of objects associated with said bit are free for storage of data." The Examiner contends that Macon discloses the first part ("the counter indicative of...words of the second data structure") and Lehman '437 discloses the second part ("wherein a second data

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structure bit...are free for storage of data"). While such features as counters, bits, clusters of objects, etc. may be well known in a vacuum, the Federal Circuit has made it expressly clear that an obviousness analysis must focus on the claim as a whole. "This is essential for combination inventions, for generally all combinations are of known elements." *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985). The Examiner has failed to focus on the claim as whole. The claim requires a counter that counts certain bits in a certain type of data structure. Neither Macon nor Lehman '437 discloses such a counter. The Examiner's reasoning to the contrary violates Federal Circuit requirements including, also, the requirement that the Examiner not view Applicant's claimed invention in hindsight. See e.g., *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (reversing the PTO's rejections).

With regard to the obviousness rejection of claim 1 over Macon in view of Shoroff, the Macon and Shoroff references were used to reject claim 1 in the final Office action. In fact, in the final Office action, the Examiner felt it necessary to combine Macon and Shoroff with Burrows. Applicant addressed this rejection in its appeal brief. As the Examiner opted not to submit an Answer and apparently conceded the argument on appeal in submitting the present Office action, Applicant is confused as to why the Examiner has again rejected claim 1 over the combination of Macon and Shoroff. Applicant's argument in regard to this ground of rejection was clearly explained in their appeal brief.

At least for these reasons, claim 1 and all claims dependent thereon are allowable over the cited art. Independent claims 10, 15, 22, 29, 36, and 50 have the same or similar limitation to the limitation quoted above from claim 1. Accordingly, such independent claims and their dependent claims are allowable for the same or similar reasons as claim 1.

The Examiner also has misread at least some of the claims. With regard to claims 15, 22, and 29, the Examiner quoted the following alleged language from the claims "consulting at least one usage counter to manage the objects." However, no such limitation appears in those claims. The Examiner's rejections

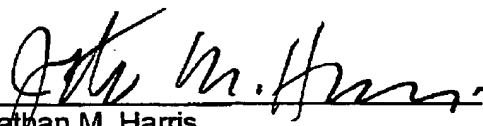
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of those claims and their dependent claims are thus in error at least for this reason.

V. CONCLUSION

Applicant respectfully requests reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,


Jonathan M. Harris
PTO Reg. No. 44,144
CONLEY ROSE, P.C.
(713) 238-8000 (Phone)
(713) 238-8008 (Fax)
ATTORNEY FOR APPLICANT

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
Legal Dept., M/S 35
P.O. Box 272400
Fort Collins, CO 80527-2400